

PATENT

C. REMARKS**1. Status of the Claims**

Claims 1-5, 7-12, 14-18, and 20-48 are currently pending. Claims 1-5, 8-12, and 15-18 stand rejected. Claims 1, 8, and 15 have been amended incorporating the limitations of claims 6, 13, and 19, respectively. Claims 6, 13, and 19 have been cancelled. Claims 21-48 have been added.

2. Supplemental Matters**A. Supplemental Information Disclosure Statement**

Applicants have filed a Supplemental Information Disclosure Statement (IDS) under separate cover. Applicants respectfully request the Examiner's consideration of the references listed in the Form 1449 included with the Supplemental IDS. Further, Applicants respectfully request a return copy of the Form 1449 noting the Examiner's consideration of such references in the next Office Communication.

B. Drawings

Applicants note that the Examiner did not indicate whether the formal drawings, filed by Applicants with the Application, are accepted by the Examiner. Applicants respectfully request that the Examiner indicate whether the drawings are accepted.

3. Claim Rejections - Double Patenting

Claims 1-5, 8-12, 15-18 stand rejected under the judicially created doctrine of double patenting over claims 1-20 of co-pending Application No. 09/714,252 and 09/714,250. Applicants

Docket No. AUS9-2000-
0470-US1

Page 13 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

currently plans to abandon both of the above-referenced Applications which will obviously remove the obviousness-type double patenting rejection. If Applicants decide to continue prosecution of either or both of the co-pending Applications, a terminal disclaimer will be filed by Applicants before issuance of either of the co-pending Applications or the instant Application.

4. Claim Rejections - 35 U.S.C. § 102

Claims 1-3, 7-10, 14-17, and 20 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,012,152 to Douik et al. (hereinafter "Douik"). Applicants respectfully traverse the rejections.

The independent claims - 1, 8, and 15, have each been amended to incorporate the limitations found in original dependent claims. Specifically, Claims 1, 8, and 15 have been amended incorporating the limitations of dependent claims 6-7, 13-14, and 19-20, respectively. As amended, each of the independent claims include the limitations of:

coordinating efforts of system operators comprising the steps of:

capturing one or more first actions taken by a first operator in an action diary;

receiving the first actions by a second operator using the action diary;

capturing one or more comments from at least one of the operators; and

storing the captured comments in the action diary.

Docket No. AUS9-2000-
0470-US1

Page 14 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

Each of the limitations included in the amended independent claims was rejected under 35 U.S.C. § 102(e) as being unpatentable over Douik. A claim is anticipated under § 102 only if each and every element of the claim is found, either expressly or inherently, in a single prior art reference. MPEP § 2131 states, in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

As described in further detail below, Douik falls short of teaching each and every element of Applicants' amended independent claims. Comparing Applicants' claim limitations with the sections of Douik cited in the Office Action make this amply clear.

Docket No. AUS9-2000-
0470-US1

Page 15 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

Applicants' first limitation is as follows: "capturing one or more first actions taken by a first operator in an action diary." This element was rejected in the Office Action citing Douik, col. 15, lines 15-25. The limitations requires an "operator" to take an action. Applicants' specification describes the "operator" as a human being that performs manual functions. For example, the specification states: "As the approaches become more automated, manual effort on the part of the operator is preferably decreased thereby increasing the efficiency of the operator as well as the efficiency of responding to system events. Operator efforts can be shifted from manual approaches to developing more and more automated approaches to system events." (Specification, page 14, lines 13-18). In addition, Applicants' figures depict the "operator" as being a human being (see Figures 2, 3, 6, 7, and 8). Despite this, the Office Action improperly substitutes Douik's "correlation agents" for Applicants' "operators." Douik describes "correlation agents" as being a program module, or in any case, different from a human being. In Figure 1, Douik shows "correlation agent 26" being one of a number of programmed components that eventually communicate with "human operator 21." (col. 14, lines 57-63). Despite Douik clearly teaching that "correlation agents" are different and separate from "operators," the Office Action substitutes a term in Douik (correlation agent) that is clearly not analogous to the element claimed by Applicants (operators). Upon review of Douik, it is clear that Douik's "operators" are not interfacing with the system taught by Douik in a manner at all similar to the interaction claimed by Applicants between Applicants' operators and the system and action diary taught by Applicants.

Docket No. AUS9-2000-
0470-US1

Page 16 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

The Office Action continues to play this "shell game" with Applicants claimed elements in the second limitation of the independent claims, namely: "receiving the first actions by a second operator using the action diary." Again the Office Action references Douik, col. 28, lines 20-65 in support of the rejection and admits that Douik is describing "diagnosis agents" rather than "operators." Interestingly, while Applicants consistently use the claim element "operator" the Office Action does not use a consistent term in its improper substitution of Applicants' "operator." As described above, the Office Action first uses "correlation agent" as analogous with "operator" and now is using "diagnosis agents" as being analogous with "operator." Again, Douik teaches that a "diagnosis agent" is a computerized process that is distinct and separate from the human operators. In Figure 1, Diagnosis Agent 28 is shown communicating with human operator 21 through GUI interface 22. Interestingly, neither the "correlation agent" nor the "diagnosis agent" even communicate directly with human operator 21 nor even with GUI interface 22. Instead, the operations of Douik's "correlation" and "diagnosis" agents are taught as being coordinated by a "super agent" (element 23, Figure 1, see also, col. 14, lines 60-67).

Applicants respectfully remind the Examiner that Applicants' claims must be examined as claimed by Applicants. MPEP § 2131 and long-standing case law requires Applicants' claims to be rejected "... only if each and every element as set forth in the claim is found..." Applicants' claims have not been examined as set forth in the claims. Instead, the Examiner has improperly substituted the words and meaning of Applicants' claim elements in order to match the cited prior art reference.

Docket No. AUS9-2000-
0470-US1

Page 17 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

The rejection set forth in the Office Action appears to be nothing more than a "rejection in search of a claim." The Examiner's attempts to pound a square peg in a round hole result in the claim that was actually examined being fabricated by the Examiner to include elements created by the examiner, and not the elements set forth in Applicants' claims. For this reason, the Examiner's rejections of Applicants' claims is entirely improper and must be withdrawn.

As discussed above, the limitations of a dependent claim have been included in Applicants' amended independent claims in order to more distinctly claim Applicants' invention. Applicants note that this amendment was made despite the fact that Douik completely fails to teach or suggest the elements included in Applicants' original independent claims.

The claims 6, 13, and 19 have been cancelled with the limitations originally found in these claims being incorporated into claims 1, 8, and 15, respectively. The limitations originally found in each of these dependent claims include: "capturing one or more comments from at least one of the operators; and storing the captured comments in the action diary." Once again, the Office Action has taken great liberty in improperly substituting words and actions from Douik and applying the improperly substituted language against Applicants claims.

In response to Applicants' limitation of "capturing one or more comments from at least one of the operators" the Office Action does not even pretend to examine Applicants' actual claim limitations. Applicants' assume the Examiner is referring to this element when asserting that Douik teaches "combining one or

Docket No. AUS9-2000-
0470-US1

Page 18 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

more second actions or comments taken by the second operator with the first actions." However, Office Action readily admits that this is not even what Douik is teaching. The Office Action states that Douik teaches "the output of the verification process is a diagnosis 29, col. 15 lines 32-40." Yet again, the Office Action abrasively massages Applicants' original claim language in order to match something found in Douik with little or no consideration for what Applicants have actually claimed.

The section of Douik cited in the Office Action states:

The diagnosis agent 28 analyzes and tests the suspect software components against their modeled behaviors under test to verify the explanations supplied by the correlation agent. The diagnosis agent may execute the tests either automatically or with the help of a human operator. The output of the verification process is a diagnosis 29 of the identity of the software component which has to be corrected, or if no explanation could be verified, a message to the correlation agent.

As described above, the diagnosis agent is separate and apart from a human operator. The cited paragraph, reproduced above, makes this point painfully clear. Douik teaches that the "diagnosis agent may execute the tests either automatically or with the help of a human operator." In other words, the diagnosis agent is something different than a human operator, which is being claimed by Applicants. The output from the diagnosis agent is a "diagnosis." This simply has absolutely nothing to do with a second operator inputting comments that are stored in the action diary, as claimed by Applicants. Not only is the diagnosis created by an automated process (the diagnosis agent) instead of a human operator, it is not taught as being stored in an action diary with previously received actions or comments. Instead, the diagnosis taught by Douik is the

PATENT

identification of a software component that needs to be corrected.

In short, Douik completely fails to teach or suggest Applicants claimed invention. Applicants note with frustration the extreme liberties taken by the Examiner in modifying Applicants' actual limitations in applying the Douik reference. For the most part, the elements and limitations examined in the Office Action simply do not appear, directly or implicitly in Applicants' claims. Instead, as pointed out above, the Examiner extensively re-wrote Applicants' claim language in order to match with the teachings of Douik by repeatedly substituting Applicants' elements with unlike and inconsistent terms found in Douik.

Claims 2-3, 7, 9-10, 14, 15-17, and 20 are dependent claims that depend, directly or indirectly, on allowable independent claims 1, 8, or 15. Therefore, these dependent claims are allowable for at least the same reasons as the independent claims are allowable. Douik completely fails to teach or suggest Applicants' claims without improperly, and extensively, rewriting Applicants' original claims, as was done repeatedly in the Office Action. The rejections of Claims 1-3, 7-10, 14-17, and 20 have been traversed as these claims are clearly allowable over Douik.

5. Claim Rejections - 35 U.S.C. § 103

Claims 4, 5, 11, 12, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Douik in view of U.S. Patent No. 6,370,563 to Murakami et al. (hereinafter "Murakami"). Applicants respectfully traverse the rejections.

Docket No. AUS9-2000-
0470-US1

Page 20 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

As an initial matter, claims 4, 5, 11, 12, and 18 each depend, directly or indirectly, on allowable independent claims as described in Section 4, above. Notwithstanding this fact, these claims are also allowable because Douik in view of Murakami fail, alone or in combination with one another, to teach or suggest Applicants' claimed invention.

Claims 4, 11, and 18 each depend upon allowable independent claims 1, 8, and 15, respectively. Claims 4, 11, and 18 each add the limitations of: "invoking a chat window on a first computer operated by the first operator and on a second computer operated by the second operator, wherein the chat window includes displaying interactive information between the first and second operators."

The Office Action admits that Douik does not teach or suggest a chat window as claimed by Applicants. However, the Office Action asserts that Douik teaches "the operator [sic] interact with each other using GUI [sic]" citing Douik, col. 28, lines 1-18. A review of the cited portion of Douik reveals, however, that Douik is teaching the use of a GUI to allow operators to interact with the computer system being taught by Douik and does not teach the use of the GUI to allow operators to interact with each other. Again, great license is taken by the Examiner in not only substituting Applicants' claim limitations and elements but also in fabricating what Douik is actually teaching.

Murakama does teach an improved chat system that provides multiple "channels" to allow the user to chat to multiple people simultaneously. (see, e.g., col. 1, lines 45-67). The Office Action states that "Operators who operate the individual

Docket No. AUS9-2000-
0470-US1

Page 21 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

terminal devices are realized" citing col. 1, lines 11-21. If the Office Action is asserting that "operators" as used in Applicants' claims are "realized," or contemplated by Murakama, the Examiner's reading of Murakama is completely misplaced. Murakama does teach a chat function among users, but does not teach or imply using the system to allow system operators to communicate with one another nor does Murakama teach or suggest saving the data in an action diary. Instead Murakama simply teaches an improved chat function that allows multiple channels.

There is simply no motivation, found in the prior art, to combine the references of Douik and Murakama. Instead, it is obvious that the Examiner improperly used Applicants' claims as guideposts in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the Office Action used impermissible hindsight in combining Douik with Murakama in order to support a rejection of Applicants' claims.

MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed

Docket No. AUS9-2000-
0470-US1

Page 22 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Applicants assert that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Office Action fails to explain how combining the telecommunications software fault management system of Douik with the chat system of Murakama would result in a workable solution without relying on Applicants' disclosure. Thus, Applicants contend that the Office Action used impermissible hindsight in rejecting Applicants' claims.

Docket No. AUS9-2000-
0470-US1

Page 23 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251

PATENT

Claims 5 and 12 depend upon claims 4 and 11, respectively and are therefore allowable for the same reasons as claims 4 and 11 are allowable. The rejections of claims 4, 5, 11, 12, and 18 have been traversed. Douik does not teach or suggest inter-operator communications means, and Murakami does not teach or suggest using a chat function in a system operator environment. Therefore, the references have been improperly combined and the Office Action used impermissible hindsight in combining the references.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By Joseph T. Van Leeuwen
Joseph T. Van Leeuwen
Attorney for Applicant
Registration No. 44,383
Telephone: (512) 301-6738
Facsimile: (512) 301-6742

Docket No. AUS9-2000-
0470-US1

Page 24 of 24

Atty Ref. No. IBM-0026

MacPhail, et. al. - 09/714,251